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BOSTON MA 02111

MAILED
JUL 28 2010
OFFICE OF PETITIONS

In re Application of :
Howard et al. : DECISION ON APPLICATION
Application No. 10/723,240 : FOR
Filed: November 26, 2003 : PATENT TERM ADJUSTMENT
Atty Docket No. 38820-526002US:

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)," filed June 22, 2010. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from five hundred seventy (570) days to seven hundred and thirteen (713) days.

The application for patent term adjustment is **GRANTED-IN-PART to the extent indicated herein.**

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is **six hundred forty-nine (649) days**. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On March 23, 2010, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is five hundred seventy (570) days. On June 22, 2010, applicants timely submitted the instant application for patent term adjustment¹.

Applicants dispute the reduction of one hundred forty-seven (147) days for filing of the "SUPPLEMENTAL AMENDMENT IN RESPONSE

¹ The Office records show applicants paid the issue fee on June 22, 2010.

OFFICE ACTION MAILED OCTOBER 9, 2008" on September 2, 2009, after a reply had been filed. See 37 C.F.R. § 1.704(c)(8)². Applicants contend that they submitted the "SUPPLEMENTAL AMENDMENT IN RESPONSE TO THE OFFICE ACTION MAILED OCTOBER 9, 2008" at the request of the examiner.

Applicants' contention is well taken. The record supports a conclusion that the supplemental reply filed September 2, 2009, was expressly requested by the examiner within the meaning of 37 CFR 1.704(c)(8). Accordingly, the reduction of 147 days is not warranted and is being removed.

Further, applicants disclose, and a review of the application history reveals, that on January 15, 2010, applicants submitted a supplemental reply or paper in the form of an Information Disclosure Statement (IDS) after filing a reply to the Notice of Allowance and Issue Fee Due on January 11, 2010. The reduction to the patent term adjustment is made pursuant to 37 CFR 1.704(c)(10), not 37 CFR 1.704(c)(8) as applicants intimate. A review of the IDS filed January 15, 2010, reveals that applicants did not include a statement under 37 CFR 1.704(d).¹ Thus, applicant failed to engage in reasonable efforts to conclude prosecution of the application. Accordingly, the

² 37 CFR § 1.704(c)(8) states:

Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed[.]

¹ Pursuant to 37 CFR § 1.704(d):

A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.


period of adjustment should have been reduced by 68 days pursuant to 37 CFR 1.704(c)(10), counting the number of days beginning on the date the IDS was filed, January 15, 2010, and ending on the mailing date of the Office action or notice in response to the IDS, March 23, 2010. Accordingly, a period of reduction of 68 days is being entered.

In view thereof, the correct patent term adjustment at the time of the mailing of the notice of allowance is **six hundred and forty-nine (649) days** (965 days of Office delay - 316 days of applicant delay = 649 days).

Submission of the \$200.00 fee set forth in 37 C.F.R. § 1.18(e) is acknowledged. No additional fee is required.

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

Telephone inquiries regarding this matter should be directed to Kenya A. McLaughlin, Petitions Attorney, at (571) 272-3222.


Anthony Knight
Director
Office of Petitions

Enclosure: Copy of REVISED PALM screen

Day : Wednesday

PALM INTRANET

Date: 7/28/2010

Time: 08:10:51

PTA Calculations for Application: 10/723240

Application Filing Date:	11/26/2003	PTO Delay (PTO):	965
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	395
Post-Issue Petitions:	0	Total PTA (days):	649
PTO Delay Adjustment:	79		

File Contents History

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79	03/10/2010	ISSUE REVISION COMPLETED			
78	03/09/2010	ALLOWED CASE RETURNED TO THE EXAMINER FOR CLERICAL PROCESSING			
77	03/09/2010	DOCUMENT VERIFICATION			
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75	01/15/2010	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
74	01/15/2010	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
73	01/15/2010	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
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65	01/15/2010	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
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56	01/11/2010	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
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54	12/17/2009	MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT			
53	12/16/2009	MISCELLANEOUS COMMUNICATION TO APPLICANT - NO ACTION COUNT			
52	12/01/2009	WORKFLOW - DRAWINGS FINISHED			
51	11/10/2009	FINISHED INITIAL DATA CAPTURE			
50	10/29/2009	MAIL NOTICE OF DRAWING INCONSISTENCY WITH SPECIFICATION			
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40	07/30/2009	DATE FORWARDED TO EXAMINER			
39	04/08/2009	RESPONSE AFTER NON-FINAL ACTION		89	35
38	04/08/2009	REQUEST FOR EXTENSION OF TIME - GRANTED			
37	04/22/2009	CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA)			

36	04/20/2009	CORRESPONDENCE ADDRESS CHANGE			
35	10/09/2008	MAIL NON-FINAL REJECTION			
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25	07/18/2007	MAIL NON-FINAL REJECTION	903		-1
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23	07/05/2005	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
22	02/08/2007	CASE DOCKETED TO EXAMINER IN GAU			
21	03/21/2006	CASE DOCKETED TO EXAMINER IN GAU			
20	07/15/2005	CASE DOCKETED TO EXAMINER IN GAU			
19	07/05/2005	REFERENCE CAPTURE ON IDS			
18.7	07/05/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
18	07/05/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
17	11/26/2004	CASE DOCKETED TO EXAMINER IN GAU			
16	11/26/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
15	08/03/2004	TRANSFER INQUIRY TO GAU			
14	07/20/2004	APPLICATION RETURN FROM OIPE			
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12	07/19/2004	APPLICATION RETURN FROM OIPE			
11	07/20/2004	APPLICATION IS NOW COMPLETE			
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		A STATEMENT BY ONE OR MORE INVENTORS			

6	06/30/2004	SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			
5	02/26/2004	NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED			
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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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